

REMARKS

This Amendment is filed in response to the Office Action dated August 17, 2007.

Rejection Under 35 U.S.C. § 103

Claims 1-2, 7-10, 13-16, 21 and 24-25 are rejected under 35 U.S.C. § 103 as being anticipated by Mankins et al. (U.S. Patent No. 6,850,209) in view of Pogue (U.S. Patent No. 3,167,874).

Claim 1 (apparatus claim) and Claim 21 (associated method claim) have been amended to recite: "...polygon display can be supported by and from the center pole solely via the single mount located within the advertising display, **wherein the single mount includes a single support brace that extends between the first display panel and the second display panel; ...** at least one electronic panel **display, wherein the single support brace is located directly behind the at least one electronic panel display.**" (Emphasis added). Support for this amendment is found in Paragraph [0075], Lines 1-3 as follows: "As shown in FIG. 12, a support brace 143 is secured to and extends between the wall members 122A and 122." "Referring now to FIGS. 3, 5, 6 and 7, the electronic panel display 12 is preferably mounted within the advertising display 10 on a support frame that is generally indicated by numeral 42." Paragraph [0053], Lines 1-4. Therefore, no new matter has been added.

In marked contrast, Pogue requires: "...a plurality of support arms radiating outwardly from said center member in two parallel planes perpendicular to the pole axis, the outer end of each arm terminating in a bent portion extending parallel to the pole axis, each of said bent portions in each of said planes being equi-angularly spaced relative to the pole axis;...". Claim

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1, Column 4, Lines 12-18. **The presence of support arms radiating from the pole axis would absolutely destroy the Applicant's Invention for its intended purpose of providing support for the electronic display so that the electronic display can be held within the advertising display. As shown in FIG. 3, the device disclosed in Pogue would not be able to support the electronic display since the electronic display would prevent the support arms from being "equi-angularly spaced relative to the pole axis."** (Emphasis added).

It is well established in U.S. Patent Law as well as the Manual for Patent Examining Procedure (M.P.E.P.) § 2143.03 that "to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). **Moreover, it is respectfully believed to be axiomatic that a feature that is not disclosed in either of two cited references can come into being by their combination.**

Moreover, there is no teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention. *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385 (U.S. 2007). The teaching, suggestion and motivation is to the contrary since Pogue requires the: "...present invention therefore provides a sign support which, although bulky when erected, may be shipped in a very compact flattened condition." (Column 3, Lines 40-42). Obviousness can only be established by combining or modifying the teachings of the prior art to

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produce the claimed invention where there is some teaching, suggestion, or motivation to do so.

In re Kahn, 441 F.3d 977, 986, 78 U.S.P.Q.2d 1329, 1335 (Fed. Cir. 2006).

The Supreme Court held in *U.S. v. Adams*, 383 U.S. 39, 148 U.S.P.Q. 479 (1966), that one important indicium of nonobviousness is “teaching away” from the claimed invention by the prior art or by experts in the art at (and/or after) the time the invention was made. This is specifically mandated by the Manual of Patent Examining Procedure (M.P.E.P.) § 2141.02, which recites: “A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

The security and stability of the electronic display located within the advertising display provides significant advantages over the combination of both Pogue and Mankins et al. A statement that modifications of the prior art to meet the claimed invention would have been “well within the ordinary skill of the art at the time the claimed invention was made” because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993). See also *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000).

Therefore, Claims 1 and 21 are patentable over Mankins et al. (U.S. Patent No. 6,850,209) in view of Pogue (U.S. Patent No. 3,167,874). Since Claims 2, 7-10, 13-16 and 24-25 depend from and contain all of the limitations of Claims 1 and 21, Claims 2, 7-10, 13-16 and

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24-25 are felt to distinguish over Mankins et al. in view of Pogue in the same manner as Claims 1 and 21. Therefore, Claims 2, 7-10, 13-16 and 24-25 overcome the rejection under 35 U.S.C. § 103. If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

Claims 17-18, 20 and 26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mankins et al. (U.S. Patent No. 6,850,209) in view of Pogue (U.S. Patent No. 3,167,874) and further in view of Goldman (U.S. Patent No. 4,679,341). Claims 17-18, 20 and 26 all depend from Claim 1 and have all of the limitations thereof. **Claims 17-18, 20 and 26 are patentable over Mankins et al. in view of Pogue in the same manner as Claim 1 above since, if an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious.** *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

Moreover, a specific requirement of Goldman is that: “The present invention comprises a modular display apparatus for slidably receiving, maintaining and displaying one or more flat multi-sided signage panels in **a desired orientation.**” (Column 1, Lines 63-66) (emphasis added). This is a marked contrast to the Applicant’s invention that specifically requires: “...wherein the at least one first display panel, the at least one second display panel and the at least one third display panel are facing **generally in different directions;**...”. (Emphasis added). Therefore, the prior art teaches away by stipulating that there must be a single **desired orientation** rather than different directions. The Supreme Court held in *U.S. v. Adams*, 383 U.S. 39, 148 U.S.P.Q. 479 (1966), that one important indicium of nonobviousness is “teaching away” from the claimed invention by the prior art or by experts in the art at (and/or after) the time the invention was made. This is specifically mandated by the Manual of Patent Examining

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Procedure (M.P.E.P.) § 2141.02, which recites: “A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

It is well established in U.S. Patent Law as well as the Manual for Patent Examining Procedure (M.P.E.P.) § 2143.03 that “to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). In this case, the limitation regarding the three displays panels facing three different directions is not found in Goldman, which requires the rectangular display panel face in a single, desired direction. When evaluating a claim for obviousness, all claim limitations must be considered. *In re Evanega*, 829 F.2d 1110, 4 U.S.P.Q. 2d 1249 (Fed. Cir. 1987).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. “The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.” *In re Kotzab*, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 U.S.P.Q.2d 1430, 1433-34 (Fed. Cir. 2002)

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(discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to modify or combine references); *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992).

Moreover, “if proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). In this case a reference, i.e., Goldman, requires the advertising display face a single “desired direction.” This will create a tremendous problem and destroy the recited purpose of the advertising display if it is simultaneously facing and viewed from three different directions. “In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification.” *In re Linter*, 458 F.2d 1013, 1016, 173 U.S.P.Q. 560, 562 (C.C.P.A. 1972).

Therefore, Claims 17-18, 20 and 26 are respectfully believed to overcome the rejection under 35 U.S.C. § 103(a) as being unpatentable over Mankins et al. in view of Pogue and further in view of Goldman.

Claim 19 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Mankins et al. (U.S. Patent No. 6,850,209) in view of Pogue (U.S. Patent No. 3,167,874) in view of Goldman (U.S. Patent No. 4,679,341) and further in view of Gebka (U.S. Patent No. 5,458,307). Claim 19 depends from Claim 18 and overcomes the rejection under 35 U.S.C. § 103(a) in the

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same manner as Claim 18 recited above. Moreover, Claim 19 depends from independent Claim

1. If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

Moreover, Gebka recites: “Since plastic price channels are generally made as extrusions of somewhat **hard polyvinyl chloride (PVC)** having a low friction or glossy outer surface, a problem which may arise in use, is that inserted labels can slide and become easily displaced along the channel to positions in which they may no longer be properly positioned relative to the products with which they are intended to be associated. The present invention **overcomes this problem**, at least to a substantial extent.” (Column 1, Lines 19-27) (emphasis added).

Therefore, although rigid PVC material is disclosed, Gebka teaches away from a hard PVC by the use of: “It is an object of the invention to provide an improved plastic price channel of the kind referred to which reduces the ability for attached labels to slide along the channel. ... The rib coating may be co-extruded from a **"flexible" PVC** such as Teknor Apex Company's 3165 Compound or Synergistics' Clear Compound 0750. Of course, these commercially available PVC extrusion compounds are identified as illustrative.” (Column 1, Lines 32-34 and 52-56) (emphasis added). Therefore, the invention in Gebka is to use a flexible PVC in a plastic price label to reduce friction when moved along the channel. Someone with ordinary skill in the art would be taught away from utilizing rigid PVC upon review of this reference for both the exterior shell and backing member. The Supreme Court held in *U.S. v. Adams*, 383 U.S. 39, 148 U.S.P.Q. 479 (1966), that one important indicium of nonobviousness is “teaching away” from the claimed invention by the prior art or by experts in the art at (and/or after) the time the invention was made. This is specifically mandated by the Manual of Patent Examining

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Procedure (M.P.E.P.) § 2141.02, which recites: “A prior art reference must be considered in its entirety, i.e., **as a whole**, including portions that would lead away from the claimed invention.” *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984) (emphasis added).

Therefore, Claim 19 is respectfully believed to overcome the rejection under 35 U.S.C. §103(a) as being unpatentable over Mankins et al. in view of Pogue in view of Goldman and further in view of Gebka.

Claim 28 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Mankins et al. (U.S. Patent No. 6,850,209) in view of Pogue (U.S. Patent No. 3,167,874) and further in view of Boland (U.S. Patent No. 1,537,523). Claim 28 is now amended to depend from Claim 1 and overcomes the rejection under 35 U.S.C. § 103(a) in the same manner as Claim 1 recited above. **If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious.** *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

Moreover, Boland also shows a pole mounted underneath a display in FIG. 1. It is well established in U.S. Patent Law as well as the Manual for Patent Examining Procedure (M.P.E.P.) § 2143.03 that “to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). Consequently, it is respectfully believed to be axiomatic that a feature, i.e., **“the single mount includes a single support brace that extends between the first display panel and the second display panel ... wherein the single support brace is**

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located directly behind the at least one electronic panel display,” (emphasis added) not disclosed in either Mankins et al., Pogue or Boland cannot come into being by their combination.

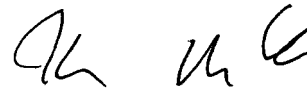
Therefore, Claim 28 is respectfully believed to overcome the rejection under 35 U.S.C. § 103(a) as being unpatentable over Mankins et al. in view of Pogue and Boland.

CONCLUSION

Therefore, it is now believed that all of the pending Claims in the present application are in condition for allowance. Favorable action and allowance of the Claims is therefore respectfully requested. If any issue regarding allowability of any of the pending Claims in the present application could be readily resolved, or if other action could be taken to further advance this application such as an Examiner's Amendment, or if the Examiner should have any questions regarding the present Amendment, it is respectfully requested that the Examiner please telephone the Applicant's undersigned attorney in this regard.

Respectfully submitted,

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